

## **REMARKS**

Claims 1, 3-6, 8-12, 14, and 16-22 are now pending in the application. Minor amendments have been made to the specification to simply overcome the objections by the Examiner. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

## **SPECIFICATION**

The specification stands objected to for certain informalities. Applicants have amended the specification according to the Examiner's suggestions. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

## **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 3-6, 8-12, 14, and 16-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Benz et al. (U.S. Pat. No. 5,645,950, hereinafter "Benz") in view of Reiser et al. (U.S. Pat. No. 4,202,933, hereinafter "Reiser"). This rejection is respectfully traversed.

At the outset, Applicants reassert the arguments previously presented regarding the improper combination of references due to impermissible hindsight and lack of suggestion and/or motivation. In his "Response to Arguments," the Examiner asserts that the combination of Benz and Reiser does not use impermissible hindsight and that proper motivation and suggestion exists for the combination thereof. Applicants respectfully disagree with the Examiner's assertions.

Specifically, with regard to Applicant's hindsight argument, the Examiner indicates that his reconstruction is permissible. The Examiner indicates that "so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." However, the Examiner fails to indicate how this knowledge was within the level of ordinary skill in the art. Applicants submit that this knowledge was in fact not within the level of ordinary skill in the art. The Examiner has provided no references indicating otherwise. Therefore, Applicants again reassert the argument previously presented that the Examiner's motivation for the rejection constructed from the combination of Benz and Reiser is the result of nothing more than impermissible hindsight and, therefore, is improper.

With regard to Applicant's previously presented argument for lack of motivation for the combination of Benz and Reiser, the Examiner cites Ex parte Obiaya, 227 USPQ 58, 60, stating: "the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." The Examiner appears to rely on Ex parte Obiaya as authority for the combination of Benz and Reiser forming a proper rejection under §103. Applicants respectfully disagree with the Examiner's interpretation of Ex parte Obiaya.

Applicants respectfully submit that the Examiner must first provide proper motivation for the combination of Benz and Reiser. The Board in Ex parte Obiaya appears to begin from a position that the combination of references therein is proper,

stating: “[w]e believe that the references clearly disclose each of the features in similar apparatus such that one skilled in the art having these references would have found the claimed invention to be obvious.” Ex parte Obiaya, 227 USPQ 58, 60. In Ex parte Obiaya, the Appellant merely argues that his claimed invention produces an unexpected result. The Board merely appears to indicate that an additional previously undisclosed advantage of a structure found in the prior art is not patentable. Applicants fail to see where the Board addresses motivation or suggestion for combinations.

As indicated above, the Board in Ex parte Obiaya begins with a proper combination of references resulting in Appellant’s claimed structure. In the present application there is no proper combination of references. Therefore, the claimed structure is not disclosed. Applicants are not claiming a new benefit of a previously disclosed structure. Rather, Applicants are claiming a new structure and related method. Applicants therefore submit that Ex parte Obiaya is not relevant to the present application. Therefore, Applicants again submit that the Examiner has failed to provide any proper motivation for the combination of Benz and Reiser.

The Examiner further asserts that Reiser teaches recycling of cathode exhaust. The Examiner then asserts that “[t]he motivation to combine comes from this teaching but also because Reiser et al. teach that cathode exhaust gas recycle would improve fuel cell stack performance.” Applicants respectfully disagree. As previously indicated, Reiser teaches recycling cathode exhaust to reduce power output of a fuel cell. The Examiner additionally notes that “Benz et al. are concerned with oxygen demand (content)(Benz et al., col. 4:32-49) wherein both Benz et al. and Scheffler et al. determine air flow by sensors 34 and 33, respectively.” In reaching his conclusion

regarding motivation for the combination, the Examiner asserts “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Benz et al. by incorporating the cathode exhaust recycle loop of Scheffler et al.” Again, Applicants submit that Reiser merely discloses a power reduction system and is not related to membrane humidification. Therefore, no motivation exists for the combination of Reiser and Benz. Further, Applicants submit that any rejections in view of Scheffler et al. were removed by the Examiner in the Office Action mailed April 14, 2006, and the current Office Action does not include any rejections based on Scheffler et al.

Applicants respectfully submit that there must be some suggestion or motivation for the combination proposed by the Examiner. Further, this suggestion or motivation may not be the result of hindsight. Applicants respectfully submit that the Examiner has not provided any suggestion or motivation other than that provided by impermissible hindsight. As indicated above, Ex parte Obiaya does not remove this requirement. As there is no suggestion or motivation for the combination of Reiser and Benz, as previously argued, Applicants respectfully submit that claims 1, 3-6, 8-12, 14, and 16-22 are in condition for allowance.

Applicants additionally note that “[v]irtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior art patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103.” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1575, 1 USPQ2d 1593, 1603

(Fed. Cir. 1987). Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-12, 14, and 16-22.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 9-8-06

By: Ryan W. Massey  
Ryan W. Massey, Reg. No. 38,543

CORRESPONDENCE ADDRESS:  
Charles Ellerbrock, Esq.  
General Motors Corporation  
Legal Staff - Mail Code 482-C23-B21  
PO Box 300 - 300 Renaissance Center  
Detroit, Michigan 48265-3000  
Ph: 313-665-4709  
Fax: 313-665-4976

RWM/JMP